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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,883	03/26/2001	Jorg Peter Schur	VONKREISLER.	8618

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DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER

YOUNG, MICAH PAUL

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/743,883

Applicant(s)

SCHUR, JORG PETER

Examiner

Micah-Paul Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46,48-53 and 55-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46,48-53 and 55-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgment of Papers Received: Request for Continued Examination dated 04/18/05.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 46, 48-53, 55, 57-61 and 64 rejected under 35 U.S.C. 102(b) as being anticipated by Honda (USPN 5,750,563 hereafter '563). The claims are to an antimicrobial composition consisting essentially of a polyphenols.

3. The '563 patent is drawn to a preparation comprising polyphenols, antimicrobial agents and lactic acid (abstract, col. 4, lin. 20-25). The composition comprises at least one gallic acid derivatives such as tannic acid; a flavonoid such as gossypetin and various extracts and essential oils such as camphor (col. 3, lin. 25-col. 4, lin. 26, claim 1). The components of the composition are present in concentrations from 0.1 to 20 % (*Ibid.*) These disclosures render the claims anticipated.

4. Claims 67-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Hughes et al (USPN 5,322,689 hereafter '689). The claims are drawn to an antimicrobial formulation comprising polyphenols and phenol compounds.

5. The '689 patent discloses a topical aromatic formulation comprising antibiotics, and carriers (col. 7, lin. 3-68). The carriers include humecatant/moisterizers like lactic acid, extracts

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such as camphor and eucalyptus oil and phenols such as thymol (examples). These disclosures render the claims anticipated.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 56 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined disclosures of Honda (USPN 5,750,563 hereafter '563), Hamilton-Miller (USPN 5,879,683 hereafter '683) and Carson et al (USPN 5,416,075 hereafter '075). The claims are drawn to a composition comprising polyphenols as extracts.

9. As discussed above the '563 patent discloses an antimicrobial composition comprising polyphenols, and other active agents. The patent suggests the inclusion of extracts of an animal or vegetable origin but is silent to the specific extracts recited by the claims. However tea

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extracts (*Camellia sinesis*) have long been known for their antimicrobial properties. These properties are discussed in the '683 and '075 patents.

10. The '683 patent discloses an antimicrobial formulation comprising tea extracts (black, green or oolong) (col. 3, lin. 52-58). These formulations are used to fight infections (abstract). One of ordinary skill would be motivated to include the polyphenols of '683 into the formulation of '563 in order to fight more microbial infections.

11. The '075 patent discloses antimicrobial emulsions comprising extracts and antimicrobial compounds (abstract). The extracts include essential oils including camphor orange oil and anise oil (col. 8, lin. 38-53). A skilled artisan would have been able to follow the suggestions '563 to include vegetable and essential oils, and include the anise oil of '075 in order to add flavor and an aromatic effect.

12. A skilled artisan would have been motivated to include the extracts of both '683 and '075 into the formulation of '563 in order to improve the antimicrobial fighting effects and improve the flavor and aromatic properties of the composition. These combinations would have been made under the suggestion of '563 to include essential oils and plant/vegetable extracts into the formulation. It would have been obvious to an artisan of ordinary skill to combine these components with an expected result of a topical formulation with improved microbial fighting and aromatic properties.

13. Claims 62,63 and 66 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the disclosures of Honda (USPN 5,750,563 hereafter '563). The claims are drawn to a formulation comprising lactic acid, and polyphenols.

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14. As discussed above the '563 reference discloses a formulation comprising lactic acid, and polyphenols. The reference discloses the concentration of the polyphenols included but is silent to the lactic acid concentration. However applicant is reminded that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *See In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).

15. Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. *See In re Russell*, 439 F.2d 1228 169 USPQ 426 (CCPA 1971).

16. Regarding claims 63 and 66 it is the position of the Examiner that any composition without an antimicrobial component is susceptible to infection. This would extend to the carrier formulation for the '563 reference. Without the antimicrobial component the carrier composition would be susceptible to infection. It is the position of the Examiner that the '563 reference is inherently a formulation microbially perishable product containing the antimicrobial composition of the invention.

17. With these things in mind it would have been obvious to a skilled artisan to follow the teachings and suggestions of the reference in order to provide an optimized antimicrobial formulation. It would have been obvious to one of ordinary skill in the art to follow these

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suggestions and teachings with an expected result of an antimicrobial formulation useful in treating infections and preserving products.

Response to Arguments

18. Applicant's arguments with respect to claims 46-68 have been considered but are moot in view of the new ground(s) of rejection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Micah-Paul Young whose telephone number is 571-272-0608. The examiner can normally be reached on M-F 7:00-4:30 every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Micah-Paul Young
Examiner
Art Unit 1618


MP Young


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600